

Serial No. 09/783,241

PD-990079

REMARKS

I. INTRODUCTION

In response to the Office Action dated February 14, 2006, the claims have not been amended. Claims 40-66 remain in the application. Re-consideration of the application is requested.

II. PRIOR ART REJECTIONS

In paragraphs (1)-(2) of the Office Action, claims 40-43, 48-52, 57-61, and 66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano et al., U.S. Publication No. 2002/0055847 (Nakano) in view of Hunter et al., U.S. Publication No. 2002/0056118 A1 (Hunter). In paragraph (3) of the Office Action, claims 46, 47, 55, 56, 64, and 65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49, and 58, and further in view of Hayward et al., U.S. Publication No. 2003/0023703 (Hayward). In paragraph (4) of the Office Action, claims 44, 45, 53, 54, 62, and 63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49, and 58, and further in view of Yamamoto et al., U.S. Patent No. 6,166,778 (Yamamoto).

Specifically, the independent claims were rejected as follows:

- As to claim 40, Nakano discloses a method for receiving subscriber information (Fig. 6) comprising:
- (a) receiving, in a set top box (10, paragraph 27), broadcast signals (paragraph 22, lines 1-7) through a tuner of the set top box (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and
 - (b) enabling a presentation device (television 12) connected to the set top box to display the broadcast signals (paragraph 22, lines 1-7);
 - (c) automatically connecting (the set top makes a connection when the card is entered; paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (wherein connection takes place upon entry of the card; paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information from the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

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It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 49, Nakano discloses a system for receiving information (Fig. 6) comprising:

a set top box is configured to:

receiving broadcast signals (paragraph 22, lines 1-7) through a tuner (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and enable a presentation device (television 12) connected to the set top box (Fig. 1) to display the broadcast signals (paragraph 22, lines 1-7);

automatically connect (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different than the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information from the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 58, Nakano discloses an article of manufacture for receiving information (Fig. 6) comprising:

means for a set top box (Fig. 1; 10) connectable to a presentation device (Fig. 1; 12) to receive broadcast signals (paragraph 22, lines 1-7) through a tuner (a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7);

means for the set top box (10) to enable the presentation device (television, 12) to display the broadcast signals (paragraph 22, lines 1-7);

means (a modem; paragraph 26, lines 1-9) for the set top box to automatically obtain a connection (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different than the tuner (Fig. 1; paragraph 22).

While Nakano discloses means for receiving information from the Internet (a modem for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal

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notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

Applicant traverses the above rejections for one or more of the following reasons:

- (1) Nakano, Hunter, Hayward, and Yamamoto do not teach, disclose or suggest a renewal notice for a subscriber; and
- (2) Nakano, Hunter, Hayward, and Yamamoto do not teach, disclose or suggest receiving a subscriber renewal notice over a connection to the Internet.

As previously described, independent claims 40, 49, and 58 are generally directed to the transmission and receipt of subscriber renewal notices through a connection to the Internet (i.e. via an ISP) rather than receiving such notices via satellite broadcast transmission. The plain meaning of the term subscriber renewal notice is a renewal notice for a subscriber. In other words, a notice for something that is being renewed for a subscriber is being sent via the Internet. Sending renewal notices over an ISP connection saves satellite bandwidth that may be made available for other broadcast information.

In addition, Applicants note that the dependent claims provide further limitations. For example, claims 42, 51, and 60 specify that the subscriber renewal notice comprises service provider facility data that is used by the set top box on a monthly basis. Further, dependent claims 46, 47, 55, 56, 64, and 65 provide for the use of a phone number that is local to the set top box that is used to connect to the Internet.

The cited references do not teach nor suggest these various elements of Applicants' independent claims. In rejecting the claim elements relating to receiving subscriber renewal notices over the Internet, the Office Action relies on Hunter paragraph 79, 82, and 83. Paragraph 82 provides that a key for each 32-bit code movie is delivered to each customer household by phone/modem on a monthly basis. The paragraph further states that the keys are only provided when the customer household is current in payments and otherwise in good standing. As can be seen from this text, the keys are keys for a particular movie. Such a key is neither similar to nor

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suggested by the claimed "subscriber renewal notice". The plain language of the terms subscriber renewal notice indicate that it is a renewal notice for a subscriber and is not a key for a particular movie that is delivered on a monthly basis. Such a movie-based key is not a subscriber renewal notice.

Paragraph 83 further describes that a movie will playback at a specific user station only when three code keys (including movie code key C) are present. Thus, rather than providing a renewal notice for a particular subscriber over a connection to the Internet as claimed, Hunter describes the delivery of a key for a particular movie over a phone/modem on a monthly basis. Such a teaching is sufficiently distinct and does not render obvious the claimed invention.

In response to the above arguments, the final Office Action submits that such subscriber renewal notices are obvious in view of Hunter's keys that are transmitted monthly to a customer household at the time of monthly billing queries if the customer is current in payments. The final Office Action further concludes that the monthly transmission of the keys to the customer (i.e., subscriber) is based upon the customer's monthly payment, which therefore constitutes a service renewal.

Applicants respectfully disagree and traverse such an assertion. Namely, code keys B described in paragraph [0081] of Hunter are keys for all movies (which are transmitted by satellite and not by a phone or modem). Further, code keys C described in paragraph [0082] are keys for each available movie. Accordingly, code key B is not similar to the present invention because it is broadcast instead of being transmitted via the Internet as claimed. Further, code key B is for all available movies compared to a subscriber renewal notice sent to an individual user. In addition, code key C is not a renewal for a subscriber. Instead, the movies change and so do the keys. Accordingly, rather than renewing something, new keys for new movies are delivered as part of code key C. In this regard, code key C is not a renewal notice but merely a key for available movies. To assert that because the keys are only transmitted when a customer is current in monthly payments, that such keys are equivalent to subscriber renewal notices is a far stretch and extends well beyond the scope of Hunter. The customer's monthly payment in Hunter is a precondition or a condition precedent for sending the code key C – code key C is not a renewal for a subscriber but merely a key for an available movie. There is a distinct and significant difference between the two.

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In addition, Applicants note that because it is a subscriber renewal notice, it can be understood that a package or something is being renewed for the subscriber – such an item cannot be per individual movies – such movies change on a monthly or more frequent basis (i.e., pay-per-views) – and can therefore not be renewed.

Applicants further note that the dependent claims provide further distinct advantages. For example, dependent claims 41, 50, and 59 provide for two particular items – (1) that the subscriber renewal notice is traditionally broadcast via satellite; and (2) broadcast information is transmitted via satellite using the bandwidth that is no longer consumed by the subscriber renewal notices. With respect to (1), there is no indication in Hunter that that Code key C is ever transmitted via satellite or that it is traditionally transmitted via satellite. Further, Hunter also fails to even remotely suggest the use of particular bandwidth for broadcast information.

In response to the above previously submitted arguments, the final Office Action states that the claim limitation is merely a benefit and while Hunter doesn't disclose such a benefit, Hunter inherently takes advantage of such a benefit. Applicants respectfully disagree. Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilton*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." The terms and stated manner in which the particular notices are traditional broadcast cannot merely be ignored with an assertion that the benefit of such limitations is inherent. Regardless of the benefit, the claim limitations exist.

In addition, Applicants note that the claim limitations also serve to distinguish subscriber renewal notices from code key C. In this regard, as set forth in Hunter, code key C is delivered by phone/modem for all available movies from a central controller system. Further, such keys are only when the customer household is current in payments. However, neither the Action nor Hunter has disclosed any transmission of all code keys C via a broadcast medium. In fact, Hunter discloses the opposite in that they are sent at the time of monthly billing queries and the only transmission described is that via phone/modem. Accordingly, Hunter's code key C cannot be the subscriber renewal notice since the subscriber renewal notice is traditionally broadcast via satellite as set forth in dependent claim 41. The fact that Hunter completely fails to describe any manner other than

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transmission via phone/modem eliminates the possibility that code key C is equivalent to the claimed subscriber renewal notice.

Dependent claims 46, 47, 55, 56, 64, and 65 provide further limitations indicating that the connection to the Internet is conducted via a phone number that is local to the STB. Applicants note that the advantage provided by such a connection provides for eliminating the use of costly 800 number connections. In rejecting these claims, the final Office Action relies on Hayward. As set forth in Hayward and the final Office Action, Hayward is directed towards a computer system (see Abstract, Fig. 1, Fig. 2, and entire specification). Applicants submit that the use of a computer as set forth in Hayward is not even remotely similar to the use of a set top box. In this regard, applications or capabilities of a computer cannot be compared or used by a set top box in a system such as that set forth in the claims. In this regard, there is no motivation to use any system of a computer in an STB. The provided motivation relies exclusively on the benefit of dialing a local phone number to connect to the Internet. However, the completely different fields of art that exist between a computer and an STB would prevent such a combination and completely fail to provide a motivation to combine.

Under MPEP 2143, it is the Examiner's obligation to set forth a *prima facie* case of obviousness. As part of establishing the case, the Examiner must meet three criteria: he must show that some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In this regard, there is no expectation of success if a computer of Hayward were combined with the systems of Nakano and/or Hunter. Further, there is no suggestion in either of the cited references or in the art itself to combine the references as set forth in the Office Action.

The various elements of Applicants' claimed invention together provide operational advantages over the systems disclosed in Nakano, Hunter, Hayward, and Yamamoto. In addition,

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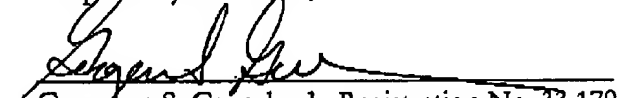
Applicants' invention solves problems not recognized by Nakano, Hunter, Hayward, and Yamamoto.

Thus, Applicants submit that independent claims 40, 48, and 58 are allowable over Nakano, Hunter, Hayward, and Yamamoto. Further, dependent claims 41-47, 49-57, and 59-66 are submitted to be allowable over Nakano, Hunter, Hayward, and Yamamoto in the same manner, because they are dependent on independent claims 40, 48, and 58, respectively, and because they contain all the limitations of the independent claims. In addition, dependent claims 41-47, 49-57, and 59-66 recite additional novel elements not shown by Nakano, Hunter, Hayward, and Yamamoto.

III. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,


Georgann S. Grunebach, Registration No. 33,179
Attorney for Applicants

Date: April 12, 2006

The DIRECTV Group, Inc.
RE / R08 / A109
P.O. Box 956
2230 E. Imperial Highway
El Segundo, CA 90245-0956

Telephone: (310) 964-4615